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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/635,624

08/10/2000

Paul A. Firestone

5848

20311

7590

12/30/2002

BIERMAN MUSERLIAN AND LUCAS
600 THIRD AVENUE
NEW YORK, NY 10016

EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,624

Applicant(s)

FIRESTONE, PAUL A.

Examiner

Jamara A. Franklin

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the receipt of the amendment filed on 10/18/02. Claims 11-24 are currently pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urbish et al. (US 5,734,343) (hereinafter referred to as 'Urbish') in view of Slavin et al. (US 5,819,234) (hereinafter referred to as 'Slavin') and Leitner et al. (US 5,587,575) (hereinafter referred to as 'Leitner').

Urbish teaches a way to eliminate the tollbooth by eliminating the need for vehicles to slow or stop and deposit toll payments at the toll booth (col. 4, lines 46-58). A plurality of labels 15 are affixed in a variety of different locations on a vehicle 10 (col. 2, lines 45-51). The label contains information of a fixed nature, for example, the vehicle identification number, in a coded form. Bar codes have been found to be the label which is most machine readable, however, icons and alphanumeric text are also quite readable and may be used effectively. These various types may be used singly or in combination in the identification label (col. 3, lines 39-51). A detector 25 is used to pick up information (including identification number) about the vehicle 10 that is read from the label 15 as the vehicle and label pass under a light source 20.

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The identification number is then used to assess tolls on the vehicle as it passes a certain location (col. 4, lines 10-29).

Urbish lacks the specific teaching of establishing an account with the identification code at a central agency and transferring data containing the identification code from the reader to the central agency.

Slavin teaches an account corresponding to a transponder 30 and unique tag number for charging toll. The account is established at a Customer Service Center 72 (col. 5, lines 53-60).

One of ordinary skill in the art would have readily recognized that establishing an account to be charged against would have been beneficial to the invention of Urbish since an account could have served as a established source for recording the charges made against the vehicle to which the account is associated. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Urbish with the aforementioned teachings of Slavin to help maintain a history of tolls collected.

Urbish/Slavin lack the teaching of moving readers.

Leitner teaches portable readers for use by police or traffic officials to scan a code that has been attached to a vehicle (col. 3, lines 18-20 and lines 60-62).

One of ordinary skill in the art would have readily recognized that moving the reader in conjunction to the code would have been beneficial to the invention of Urbish/Slavin for allowing the code to be read in a variety of conditions and situations including a case where the vehicle to which the code is affixed is located in an area not equipped for a fixed reader. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Urbish/Slavin with the moving reader as taught by Leitner. Furthermore, the notion

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that a device can be made movable or portable holds no patentable weight unless there are new and unexpected results.

Response to Arguments

3. Applicant's arguments filed 10/18/02 have been fully considered but they are not persuasive.

In response to applicant's argument that the Urbish and Leitner references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the Urbish and Leitner references involve reading a bar code which is affixed to a vehicle. However, as noted in the above rejection, making a device portable or movable is not sufficient to patentably distinguish the claimed invention of the instant application from the invention of Urbish/Slavin.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

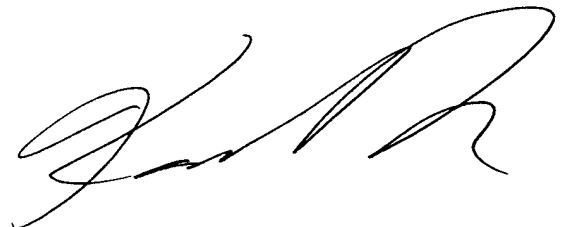
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (703) 305-0128. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jamara A. Franklin
Examiner
Art Unit 2876

JAF
December 21, 2002

A handwritten signature in black ink, appearing to read 'Karl D. Frech', with a stylized, cursive script.

KARL D. FRECH
PRIMARY EXAMINER